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TOWNSEND and TOWNSEND and CREW LLP

By: Bonnie Rickles
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Jeffrey G. Nowlin et al.

Application No.: 10/028,888

Filed: December 19, 2001

For: WEIGHT MEASURING SYSTEMS
AND METHODS

Examiner: Richard S. Woo

Art Unit: 3629

APPELLANTS' SUPPLEMENTAL REPLY
BRIEF UNDER 37 CFR §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Supplemental Reply Brief is filed in response to the Examiner's Answer of
September 13, 2007.

ARGUMENT

Applicants apologize for the additional paper in this appeal. However, in the
current Examiner's Answer (September 13, 2007), which appears to be a substitute for the
original Answer (mailed October 26, 2004), there is no reference to or apparent consideration of
the earlier Reply Brief filed by Applicants (November 22, 2004). It is believed remarks made by

the Examiner in the current Examiner's Answer were addressed in the earlier Reply Brief. Applicants have attached a copy of the earlier Reply Brief (rather than merely repeating those arguments herein), and respectfully request that such arguments therein be considered by the Board in rendering a decision.

Applicants believe all pending claims are in condition for allowance. It is respectfully requested that the Examiner's rejection of the claims be reversed.

Respectfully submitted,



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PATENT
Attorney Docket No.: 020375-006500US

"Express Mail" Label No. EV 470761530 US
Date of Deposit November 22, 2004

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By:



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APPELLANTS' REPLY BRIEF UNDER 37
CFR §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is filed in response to the Examiner's Answer of October 26,
2004.

ARGUMENT

In the Answer, the Examiner reiterated the rejection of all pending claims under 35 U.S.C. 102(b) as being anticipated by **Long** (EP 0,621,563). The Examiner stated that claim 15 is the broadest claim, and that **Long** discloses all the structural elements of claim 15. The Examiner further stated that **Long** is "capable of performing the intended use" recited by Applicants in functional limitations in claim 15.

Applicants respectfully disagree with the Examiner's statements.

First, **Long** is structurally different than Applicants' claimed invention. **Long** discloses data cards 32 that have a data record read by a reader 34 in order to (1) determine which inserts to include with the card (see col. 5, lines 42 through 56) and (2) later print certain information on a letter sheet to accompany the card (see col. 6, lines 6 through 23). The Examiner appears to state that Applicants' identifier is met by either (1) the data record on the card or (2) the information that is printed on the letter sheet.

Neither "identifier" in **Long** is the same as Applicants' identifier. Applicants' identifier is printed on a mailing component after it is provided to the system, and it is thereafter read for purposes of identifying inserts. In **Long**, the data record on the card is read by a reader 34, but such identifier is a data record on the card that is printed or stored before the card is provided to the system. The second "identifier" in **Long**, i.e., the information that is printed later in the system and on the letter sheet accompanying the card, is not read by any reader within the system, and is certainly not read to determine inserts.

The reader (27, 66) in **Long** that is referred to by the Examiner is a sensor used to determine the position of the paper, not to read an identifier (see col. 4, lines 42 through 46). The reader 34 in **Long** might be argued as analogous to Applicants' reader (even though not so argued by the Examiner), but it does not read an identifier printed within the system (i.e., "after" the mailing component "has been provided to the system", as in claim 15). Thus it is not possible for the **Long** structure to print an identifier that is subsequently read to determine mailing inserts. First, it would be impossible for the reader 34 to both read an identifier on the card and to also read an identifier that is subsequently printed on the sheet accompanying the

card. The reader 34 is not physically positioned to read both (it is located to read cards received from a card feeder, not read letter sheets). Secondly, the reader 34 must read the data record on the card in order to determine the information to be printed on the letter sheet, and thus logically it would make no sense (and there would be no reason) for it to read the data record on the card in order to determine information to be subsequently printed on a letter sheet, and then later also read the subsequently printed information on the letter sheet.

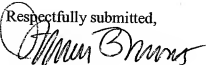
Long is not capable of performing the functions of Applicants' claimed invention. Applicants' functional limitations in claim 15 (i.e., a printer that prints an identifier on a mailing component "after that one of the components has been provided to the system, wherein the identifier is used to identify components of the mailing unit") are not inherent characteristics of the system disclosed in **Long**. Thus, **Long** does not disclose the claimed invention.

Further, the Examiner appears to argue that he may ignore the functional limitations recited by Applicants in claim 15. The Examiner states that this limitation is merely "a recitation of intended use". If the Examiner's reasoning were to be upheld by the Board, it would permit an Examiner to ignore any functional limitation as a "recitation of intended use". Applicants' definition of its printer is a definition of the element according to what it does functionally, rather than what it is structurally. Such recitation is proper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). Such a recitation may not be ignored by the Examiner. *In re Atwood*, 354 F.2d 365, 148 USPQ 203 (CCPA 1966).

Finally, Applicants believe the Examiner's statement that claim 15 is the broadest claim is not correct. Method claim 1 is as broad, if not broader, than claim 15. In claim 1, Applicants recite method steps without many of the structural limitations of claim 15. One of the method steps in claim 1 is "printing at the system an identifier on one of the components forming the mailing unit after that one of the components has been provided to the system, wherein the identifier may be used in identifying the components of the mailing unit." Such a limitation is clearly not found in **Long**.

Applicants believe all pending claims are in condition for allowance. It is respectfully requested that the Examiner's rejection of the claims be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Stephen F. Jewett", is written over the typed name.

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